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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/832,416	04/10/2001	Wolfgang Bartsch	7108 US	9542
30078 7590 05/29/2007 MATTHEW D. RABDAU TEKTRONIX, INC. 14150 S.W. KARL BRAUN DRIVE P.O. BOX 500 (50-LAW) BEAVERTON, OR 97077-0001			EXAMINER DUONG, FRANK	
			ART UNIT 2616	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

### Application No.

09/832,416

### Applicant(s)

BARTSCH, WOLFGANG

### Examiner

Frank Duong

### Art Unit

2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2006 and 15 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This Office Action is a response to communications dated 02/13/06 and 03/15/06.

Claims 1-5 are pending in the application.

#### ***Information Disclosure Statement***

2. The information disclosure statement (IDS) filed 12/08/05 and duplicate IDS filed 02/13/06 comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609. They have been considered accordingly and placed in the application file.

#### ***Claim Objections***

3. Claims 1 and 4 are objected to because of the following informalities:

As per claim 1:

Line 4, the term "adapted to" should be replaced with --configured to--. A typical reason for doing so is that such term or claim language suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure. See MPEP § 2111.049 [R.3].

Line 6, the term "may be" should be replaced with --are--. A typical reason for doing so is that such term or claim language does not positively recite a limitation or limit a claim to a particular structure. See MPEP § 2111.049 [R.3].

Appropriate correction is required.

As per claim 4, line 7, the term "may be" should be replaced with --are-- for the same rationales discussed above.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Yang (Protocol Compatibility Tester for CDMA Mobile Systems (CMS), IEEE, pages 96-101) (hereinafter "Yang").

Regarding **claim 1**, in accordance with Yang reference entirety, Yang shows a decoding device for analyzing communication protocols (*Figs. 2; section 2.1*) comprising:

a generic decoder (*Fig. 2; PAST Interface Controller or Lower Tester*) into which a limited number of protocol descriptions (*PDLs discussed on page 97*) are loaded, the generic decoder adapted to interpret the protocol descriptions (*page 97*); and

a specific decoder (*Fig. 2; Machine (IBM compatible PC) or Upper Tester*) designed for a certain protocol description (*page 99, section 3.2; RS-422 or T1*), the generic and specific decoders being reversibly connected so that the generic and specific decoders may be updated separately (*see Figs. 2 and 6 for connection details. There is beyond reason of doubt that PAST Interface Controller (Lower Tester) and IBM compatible PC (Upper Tester) can be separately updated*).

Regarding **claim 2**, in addition to features recited in base claim 1 (see rationales discussed above), Yang further shows wherein the generic decoder comprises at least

one element function (system program) that *may be* overlaid by a corresponding element function (*HD64180*) of the specific decoder (*page 99, section 3.2, it is disclosed the IBM compatible PC/486 can thus download to the HD64180 system program, which can be then be executed autonomously*).

Regarding claim 3, in addition to features recited in base claim 2 (see rationales discussed above), Yang further shows wherein the one overlaid element function is interpreted by the generic decoder (*page 97, section 3.1, it is disclosed the PDLs designed for protocol testing*).

Regarding **claim 4**, in accordance with Yang reference entirety, Baker discloses a method of setting up a decoding device (*Fig. 2*) comprising the steps of:

provisioning a generic decoder (*Fig. 2; PAST Interface Controller or Lower Tester*) into which a limited number of protocol descriptions (*PDLs discussed on page 97*) of communication protocols are loaded, the protocol descriptions being interpreted by the generic decoder (*page 97*);

provisioning a specific decoder (*Fig. 2; Machine (IBM compatible PC) or Upper Tester*) for a certain protocol description (*page 99, section 3.2; RS-422 or T1*); and reversibly connecting the generic and specific decoders to form the decoding device so that the generic and specific decoders may be updated separately (see *Figs. 2 and 6 for connection details. There is beyond reason of doubt that PAST Interface Controller (Lower Tester) and IBM compatible PC (Upper Tester) can be separately updated*).

Regarding **claim 5**, in addition to features recited in base claim 4 (see rationales discussed above), Yang further discloses wherein the generic decoder comprises at

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least one element function (system program) overlaid by a corresponding element function (*HD64180*) of the specific decoder during connection of the generic decoding with the specific decoder (*page 97, section 3.1, it is disclosed the PDLs designed for protocol testing*).

### ***Response to Arguments***

5. Applicant's arguments filed 02/13/06 have been fully considered but they are not persuasive.

In the Remarks of the outstanding response, pertaining the rejection of claims 1-5 under 35 U.S.C 102(b) as being anticipated by Yang, Applicant argues "In contrast, Applicant's invention consists of a generic decoder and a specific decoder operating ***in corporation***: The generic decoder interprets protocol descriptions to provide flexibility for many protocols. For specific protocols which require more efficiency, simplicity, or ease of maintenance than the generic decoder offers, the specific decoder is used instead, thereby ***supplementing*** the generic decoder. This cooperation between the decoders can be abstracted by the use of element functions: A protocol within the specific decoder can be overlaid and interpreted by the generic decoder," (emphasis added by Examiner).

In response Examiner respectfully disagrees for the following rationales:

First, a careful review of the disputed claims, Examiner finds no such language in the claims. Perhaps Applicant refers to certain features that are disclosed in the present application but not recited in the reject claims in making the contention that the

Yang reference fails to show certain feature of Applicant's invention. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Second, Examiner asserts the Yang reference, as clearly pointed out in the Office Action, does indeed anticipate the claims in the present condition.

Examiner also would like to point out that for some unknown reasons the Applicant has copied the pre-amended limitations of the old claims verbatim and argued based on them. Such action is rather hasty.

Examiner believes an earnest attempt has been made in addressing all of the Applicant's arguments. Due to the response fails to place the instant application in a favorable condition for allowance, the rejection is maintained.

### ***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed; and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Duong whose telephone number is 571-272-3164. The examiner can normally be reached on 7:00AM-3:30PM, Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynn D. Feild can be reached on 571-272-2092. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



**FRANK DUONG**  
**PRIMARY EXAMINER**

May 21, 2007